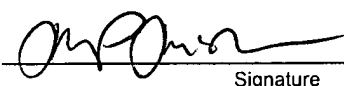


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 113737.7	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/031,542	Filed  01/18/2002	
	First Named Inventor  Christoph Gebhardt		
	Art Unit  2881	Examiner  Phillip A Johnston	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 46,922 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Signature  
Matthew P. McWilliams  
Typed or printed name  
(215) 988-3381  
Telephone number  
February 21, 2006  
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Christoph Gebhardt et al.

Application No.: 10/031,542

Group Art Unit: 2881

Filed: January 18, 2002

Examiner: Phillip A. Johnston

Title: Method and Device for Cluster Fragmentation

Attorney Docket No.: 113737.7

Mail Stop AF  
Commissioner for Patents  
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Alexandria, VA 22313-1450

**Comments on Examiner's Reasons for Rejection in Conjunction with  
Request for Pre-Appeal Conference**

Claims 22 to 52 are currently pending in the instant application.

In the final Office Action dated November 28, 2005, Claims 22 to 29, 31, 34 to 40, 42, 43, 45, 46, 48, 49, 51 and 52 were rejected as obvious over U.S. Patent No. 4,845,367 to Amirav ("Amirav") in view of U.S. Patent No. 4,755,344 to Friedman ("Friedman"). Claims 30, 32, 33, 41, 44, 47 and 50 were rejected over Amirav in view of Friedman, further in view of U.S. Patent No. 4,851,669 to Aberth ("Aberth"). These are essentially the same rejections of the claims made by the Examiner in the previous Office Action, mailed June 2, 2005. The Examiner has ignored the deficiencies of Amirav, Friedman and Aberth pointed out by Applicant in the response to the June 2<sup>nd</sup> Office Action, and failed to fully address Applicant's arguments regarding the rejections. Thus, the rejection of the claims are appealed. Claim 22 is the sole independent claim.

### **The References Do Not Teach the Features Alleged by the Examiner**

Throughout the Office Action mailed on November 28, 2005 (“Office Action”) the Examiner has cited to Amirav, Friedman and Aberth for elements of the claims that those references do not disclose. For example, at page 4 of the Office Action the Examiner states that Amirav discloses “(b) impinging clusters on solid surfaces to initiate reactions” citing to column 2, lines 43-65. A review of the cited section of Amirav reveals no such disclosure. Applicants had previously pointed this deficiency out to the Examiner at page 4 of the Office Action response filed September 13, 2005 (“Response”). Further, at page 4 of the Response Applicants pointed out that Amirav actually teaches using a light gas as a carrier and minimizing cluster formation.

Also at page 4 of the Office Action the Examiner states that Amirav discloses “(c) fragmenting chemically converted samples through excitation and forming both positive and negatively charged fragments” citing to column 2, line 55-68. Again, Applicants pointed out in the Response at page 4 that Amirav teaches molecular ionization, not cluster fragmentation.

At page 6 of the Office Action the Examiner states that Aberth teaches that it is known to direct neutral clusters at a target, citing to column 4, lines 20-60 and column 8, lines 45-65 of Aberth. However, as pointed out by Applicants at page 7 of the Response, Aberth teaches directing cesium cluster ions (not neutral clusters) at a target containing a sample to generate ionized fragments of the sample.

If the Examiner believes that the references inherently disclose the claimed features, he has not provided a reference in the prior art to demonstrate the inherency. Instead the Examiner has substituted his own *post factum* analysis of the references to read critical limitations into the

references and piece together the invention based on his own expertise and his own knowledge of the claimed invention; e.g. at page 9 of the Office Action, “The examiner has interpreted from the references above that Amirav (367) discloses the use of polar molecules in carrier gases for producing positive and negative ions, as recited in claim 22.” (Emphasis added) Similar analyses by the Examiner appears at pages 11 and 12 of the Office Action.

**The Examiner has not Provided a Sufficient Rationale for Combining the References**

The Examiner has stated in the Office Action that it would be obvious to combine or modify Amirav, Friedman and Aberth without providing a sufficient rationale for doing so. See pages 5 and 6 of the Office Action. For example, at page 5 of the Office Action the Examiner asserts it would have been obvious to replace the light gas carrier of Amirav with clusters of water molecules taught in Friedman. There are no citations to the prior art to show where the references or knowledge generally available to one skilled in the art suggest the proposed combination of Amirav and Friedman. The closest that the Examiner has come to doing this is at page 9 of the Office Action, where the Examiner cites to column 2, lines 10-20 of Amirav, which states “theoretically, almost any molecule or atom can be used for producing positive ions, and almost any molecule, atom, or molecule with a fragment having a high electron affinity can be used for producing negative ions.” (Emphasis added). Applicants respectfully submit that this does not represent a sufficient rationale for combining references to establish a *prima facie* case of obviousness.

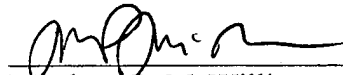
Further, the Examiner has ignored instances where references teach away from the proposed modifications; e.g. Amirav teaches minimizing cluster formation; Amirav teaches using a light gas as a carrier; Friedman teaches forming cluster ions.

### Conclusion

The Examiner has failed to show where the cited references explicitly disclose each and every element of Claims 22 to 52. Further, the Examiner has failed to show, based on the prior art, that the cited references inherently disclose any elements not explicitly disclosed. Further, the Examiner has failed to provide a sufficient rationale, found in the prior art or knowledge generally available to one of ordinary skill in the art, that would motivate one to modify and combine the references as suggested. Finally, the Examiner has ignored instances where the references explicitly teach against the proposed combinations. Each of these deficiencies has been previously pointed out to the Examiner by the Applicants. Therefore Applicants respectfully appeal from all of the current rejections.

Respectfully submitted,

BY:



Matthew P. McWilliams  
Registration No. 46,922  
DRINKER BIDDLE & REATH LLP  
One Logan Square  
18<sup>th</sup> and Cherry Streets  
Philadelphia, PA 19103-6996  
Tel: (215) 988.3381  
Fax: (215) 988.2757

February 21, 2006